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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/500,747	02/09/00	GOKHALE	R 300622004600

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EXAMINER

KERR, K

ART UNIT

PAPER NUMBER

1652

6

DATE MAILED:

06/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/500,747

Applicant(s)

GOKHALE ET AL.

Examiner

Kathleen M Kerr

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1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Application Status

1. Claims 1-22 are pending in the instant application.

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to methods of making polyketide synthases (PKSs), classified in class 435, subclass 183.
 - II. Claims 6-18, drawn to PKSs, classified in class 435, subclass 183.
 - III. Claims 19-21, drawn to methods of making polyketides, classified in class 435, subclass 76.
 - IV. Claim 22, drawn to polyketides, classified in class 568, subclass 382.
3. The inventions are distinct, each from the other because of the following reasons.

Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the PKSs can be made by recombinant methods using genetic manipulations of the genes encoding the PKSs. Therefore, Groups I and II are patentably distinct.

Groups I and III are related by virtue of the common PKS; Group I is drawn to methods of making the PKSs and Groups III is drawn to methods of using the PKSs. However, these

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Groups have wholly different methods steps to produce wholly different products. Their distinctness is also evidenced by their distinct class/subclass classification. Therefore, Groups I and III are patentably distinct.

Groups I and IV are related by virtue of the PKSs which are made in the Group I and which, when allowed to catalyze their intended biosynthetic reactions, produce the polyketides of Group IV. However, the products of Group IV are not specifically produced by practicing the method steps of Group I. Moreover, the distinctness of these Groups is evidenced by their distinct class/subclass classification. Therefore, Groups I and IV are patentably distinct.

Groups II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the PKS can be used in wholly distinct processes of using the products, for example, in the production of antibodies. Therefore, Groups II and III are patentably distinct.

Groups II and IV are related because the PKSs of Group II, when allowed to catalyze their intended biosynthetic reactions, produce the polyketides of Group IV. However, the products of Group IV are wholly distinct functionally and structurally from the products of Group II. Moreover, the distinctness of these Groups is evidenced by their distinct class/subclass classification. Therefore, Groups II and IV are patentably distinct.

Groups III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

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used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the polyketide products can be produced by wholly different methods, such as organic synthetic methods. Therefore, Groups III and IV are patentably distinct.

Notice of Possible Rejoinder

4. The Examiner notes that if the products of Group II are found directed to an allowable product, then the methods of Groups I and III, which are directed to processes of making or using the patentable product, respectively, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also MPEP 821.04, *In re Ochiai*, and *In re Brouwer*). Additionally, if the products of Group IV are found directed to an allowable product, then the methods of Group III, which are directed to processes of making the patentable product, would be rejoined with Group IV. Since process Groups I and III would be rejoined and fully examined for patentability under 37 C.F.R. 1.104, Applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

Election

5. A telephone call was made to Ms. Kate Murashige on June 7, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Conclusion

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-0000 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PONNATHAPUACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

KMK
June 7, 2001